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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/691,907 | 10/23/2003 | Robert Galli | P00573-US2 | 6537 |
| 3017 | 7590 | 12/16/2005 | EXAMINER | |
| BARLOW, JOSEPHS & HOLMES, LTD. | | | CHOI, JACOB Y | |
| 101 DYER STREET | | | ART UNIT | |
| 5TH FLOOR | | | PAPER NUMBER | |
| PROVIDENCE, RI 02903 | | | 2875 | |

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/691,907

Applicant(s)

GALLI, ROBERT

Examiner

Jacob Y. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 7-10 & 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the primary tool must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

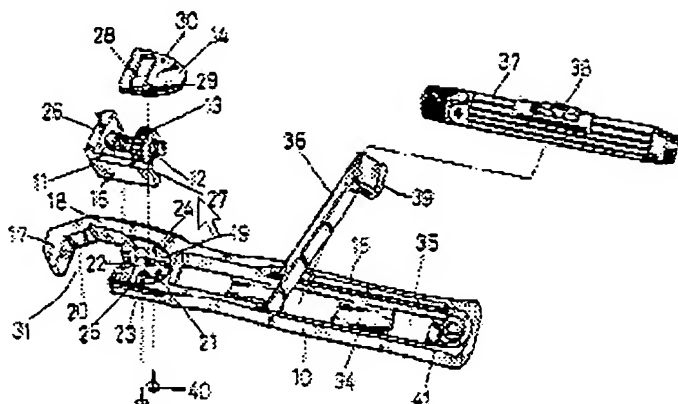
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5, 6, 11 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (USPN 6,334,693).

Regarding claim 5, Lee discloses a housing (10) having a primary compartment (19), the primary compartment (19) being configured to receive a primary tool (11), the housing including a front end (17), a back end (opposite end of the front) and a top surface (Figure 1), and a channel (15) forming a secondary compartment (rear end/10) in the back end of the housing, the channel (15) having a bottom wall (34) and a side wall (e.g., near 15) extending upwardly between the bottom wall (34) and the top surface with an opening in the side wall at the back end of the housing (10), the channel (15) slideably receiving and retaining a secondary tool (flash light) through the opening in the side wall (e.g., near 15) the channel (15) including mating formation adapted to engage and retain the secondary tool (flash light).



Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 6, Lee discloses a closure element (36) pivotably connected to the back end of the housing (10), the closure element (36) being pivotably from a first open position to a second closed position over the opening in the sidewall (e.g., near 15) wherein the closure element (36) in the closed position retains the secondary tool (flash light) in the channel (15).

Regarding claim 11, Lee discloses an outer casing (10) for receiving and enclosing primary device (11), the outer casing (10) having a front end (17), a back end (opposite end of the front) and a top surface (Figure 1), and a channel (15) forming a secondary compartment (rear end/10) in the back end of the housing, the channel (15)

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having a bottom wall (34) and a side wall (e.g., near 15) extending upwardly between the bottom wall (34) and the top surface (Figure 1) with an opening in the side wall (e.g., near 15) at the back end of the housing (10), the channel (15) to slideably receiving and retaining a secondary tool (flash light) through the opening in the side wall (e.g., near 15) the channel (15) including mating formation adapted to engage and retain the secondary tool (flash light).

Regarding claim 12, Lee discloses a closure element (36) pivotably connected to the back end of the housing (10), the closure element (36) being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element (36) in the closed position retains the secondary tool (flash light) in the channel.

Response to Amendment

4. The examiner acknowledges that the applicant has amended claims 5 & 11. Claims 1-4, 6-10 & 12-19 remain unchanged, accordingly, claims 1-19 are pending in the application.

Response to Arguments

5. Applicant's arguments filed 9/27/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not clearly shown in drawing figures or disclosed in the originally filed & amended specification, providing limited understanding of the term "primary tool". Amendment to the specification filed on 7/05/2005 vaguely mentioned that *"the flashlight 14 further includes an operational light assembly generally indicated at 16, received and enclosed with a primary interior compartment 17 at one end of the housing 15 ... etc"* and failed to additionally disclose what the "primary tool" comprise of.

Applicant's argument is not properly supported when stating, *"one skilled in the art would never refer to the moving portion of the wrench as a tool unto itself"* because applicant him/herself is failed to provide any specific meanings behind what the "primary tool" is.

One in ordinary skill in the art would never be able to understand what applicant's definition of the "primary tool", when the specification does not clearly provide support thereof, other than it may be parts of the flashlight. Also, one in ordinary skill in the art/the examiner would broadly understand the term "tool" as it is defined in the dictionary, where claims in a pending application are given their broadest reasonable interpretation, therefore, the term "primary tool" is interpreted as a device, used to perform or facilitate manual or mechanical work. The examiner can only predict that the "primary tool", in the claims, may be portions of the flashlight including light bulb(s), reflector, socket, electrical connection, battery(s), switch ... etc, which may be considered as a tool by applicant's vague support in the specification, similar to prior art

reference Lee. In other words, applicant's specification failed to provide any defined meanings of the term "primary tool" and prior art reference Lee clearly discloses (e.g., 11) an element/device/tool that is mechanically facilitated by a housing having a primary compartment meeting applicant's claimed limitation(s).

Allowable Subject Matter

6. Claims 7-10 and 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claim 1 recites a housing having a channel configured within the top surface and extending inwardly from a peripheral edge of the back end of the housing, the channel having a bottom wall and opposing side walls extending upwardly from the bottom wall, and further having an opening in the side wall *at the back* end of the housing, the channel being configured to slideably receive a removable tool, the channel and the removable tool having complementary formations for interfitting engagement thereof, and a closure element movably coupled to the back end of the housing.

Claim 17 recites a secondary compartment having a front end, a back end, a top surface, and a channel configured within the top surface, the secondary compartment being configured to slideably receive the pocket knife in interfitting mated relation

therein & the secondary compartment and the pocket knife having complementary formations for interfitting engagement thereof.

Lee (USPN 6,334,693) teaches wrench / casing having channels & a closure element for a portable flashlight.

Because none of the reference cited discloses the combination of a case / housing assembly having both primary compartment and a secondary compartment / channel where secondary compartment / channel is configured to slideably receive the pocket-knife / removable tool in interfitting mated relation & the casing comprising a closure element removably coupled to *the back end* of the housing proving an open and close operation, nor is there any motivation to combine them, the claims are deemed patentable over the prior art of record. Claims 1-4 and 17-19 are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



JOHN ANTHONY WARD
PRIMARY EXAMINER